D. Remarks

Rejections Under 35 U.S.C. §112, Second Paragraph.

Claims 1 and 13 have been amended to address the ground for rejection.

The term found confusing by the Examiner has been deleted from claim 1. It is believed that one skilled in the art would not find amended claim 1 confusing, particularly in light of the following portion of Applicant's Specification:

> There are a large number of homes and buildings that have been wired for telephone service, and the wiring usually can only accommodate one or two phone lines. Attached to these phone lines can be several phones, but only one phone per line can be in use on separate conversations at one time (Applicant's Specification, Page 2, Lines 20-23).

Claim 13 has been re-written to distinguish an LTW hang up packet from a VDM hang up packet.

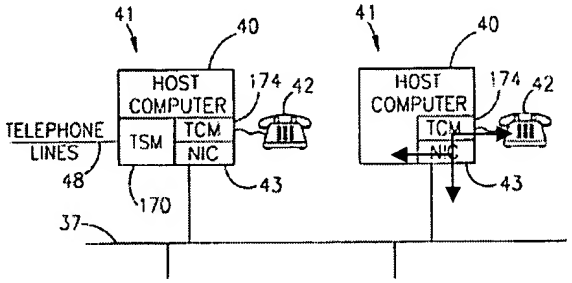
Rejection of Claims 1-4, 11 and 12 Under 35 U.S.C. §102(b) based on *Baratz et al.* (U.S. Patent No. 5,742,596).

Amended claim 1 is directed to a voice and data network. The voice and data network includes (a) a telephone and a computer connected to a voice and data module (VDM), the telephone and computer having unique assigned addresses, (b) a plurality of said VDM devices connected to a plurality of telephone wires in a building, (c) said plurality of telephone wires connected together to provide a telephone network for a telephone service in which only one phone can communicate on a given line at one time, (d) a link to wide area network (LTW), (e) said LTW and said plurality of said VDM devices communicate together over said telephone network using communication addresses assigned to said LTW and each VDM of said plurality of VMD devices.

As is well known, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference.

As emphasized above, in Applicant's amended claim 1, a telephone and a computer connected to the same VDM have unique addresses. This is not shown or suggested by the cited reference *Baratz et al.*

Applicant has previously noted that in *Baratz et al.*, phones are connected to the network through host computers by way of network interface cards (NICs).



Both phone (42) and host computer (40) access network (37) through NIC (43).

Consequently, in *Baratz et al.* the phones do not have addresses. Phones have extensions, but such extensions are related to the NIC address, as noted in the reference.

> The physical extension numbers are directly related to the ***unique network address of the host computer 40 that telephone set 42 is connected to***. In a similar manner telephones connected to a remote subscriber interface module are assigned unique physical address. (*Baratz et al.*, Col. 6, Lines 20-24)

Thus, in *Baratz et al.* a telephone has the same network address as its host computer. This is in contrast to Applicant's amended claim 1, which recites different addresses for a computer and phone connected to a VDM.

Applicant notes that nothing in *Baratz et al.* shows or suggests that the telephone sets (42) have a different address than the host computer to which they are connected.

A rejection has been maintained with respect to this limitation by arguing that various teachings "must" be present in the reference:

> The term "address" is a broad term and in this case each telephone and host computer ***must*** have unique addresses. Namely, although the Telephony server

> used the MAC/Physical address of the host PC in order to determine where to send the packets, the host computer must also use some kind of addressing scheme to determine where to forward the packet. Specifically, the host computer must determine which received packets are for the connected telephone and which are data packets that are to be used by the host computer (Final Office Action, dated 08/09/04, Page 12, Lines 1-7).

The above reasoning is not sufficient to show anticipation for a number of reasons.

First, the statement that certain teaching must follow from the reference, unsupported by any citation to the reference at hand, cannot meet the necessary burden placed on the Examiner. Applicant has shown above that *Baratz et al.* explicitly describes voice and data packets as having the same physical address. Such a showing cannot be rebutted by the conclusion that certain teachings must be included in the reference. If the Examiner is arguing that the above noted teachings are inherent in the reference, the above showing is still not sufficient.

> [W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art.[1]

Second, the statements relied upon by the rejection are believed to misstate the operation of the *Baratz et al.* system. The rejection statement "the host computer ***must*** determine which received packets are for the connected telephone and which are data packets that are to be used by the host computer" does not reflect the operation of *Baratz et al.* In fact, the system of *Baratz et al.* intentionally ensures that there is no distinguishing between voice and data packets:

> System 10 generated voice or control packets sent out over the LAN are treated no differently than and have equal priority with other non-voice data packets originating from other devices on network 37. (*Baratz et al.*, Col. 46-49).

[1] In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (citing In re Yates, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (C.C.P.A. 1981))

Because voice and data packets in *Baratz et al.* have the same network address, Applicant believes that the host computer cannot distinguish packets at the data link layer. A process (e.g., application in conjunction with the operating system) running on the computer can subsequently distinguish packet payload data according to higher protocol information.

The rejection also relies on teachings regarding higher level protocol layers to argue that Applicant's claim 1 limitations are shown.

> [T]he host computer must determine which port to send out the telephone call packet corresponding to the telephone. Therefore, the MAC address of the host computer is a unique address of the computer and that same MAC address *in* combination with the port number corresponding to the telephone, as a whole can be considered a single address and thus each telephone and computer has an associated unique address. (Final Office Action, Page 12, Lines 7-12).

Again, Applicant respectfully requests where port numbers are described either explicitly or inherently within *Baratz et al.* Applicant could only find one reference to a higher level protocol layer in the cited reference. The reference mentions IPX/SPX (see *Baratz et al.*, Col. 5, Lines 40-42), however IPX/SPX utilizes "sockets", not ports.

Finally, the above reliance on ports (i.e., higher protocol layer information) to distinguish separate addresses between a host computer and attached phone is believed to be artificial. As is well known, port information (assuming UDP or TCP protocols) resides at the network/transport layer (assuming the OSI model). Such port information identifies a process or application, not a particular device (in support, please see Applicant's Exhibit A attached hereto). Thus, a port is not assigned to the host computer, but rather to an application/process residing on the computer.

Such arrangements gives rise to cases in which a voice packet having the same physical address and destination socket will be delivered to either an attached phone or to computer hardware. *Baratz et al.* explicitly describes applications that service both an attached phone and computer hardware. In particular, *Baratz et al.* shows a record/playback application. A voice packet arriving to the computer would have its voice data payload output to the phone, or

recorded onto media within the computer for subsequent playback, according to application conditions:

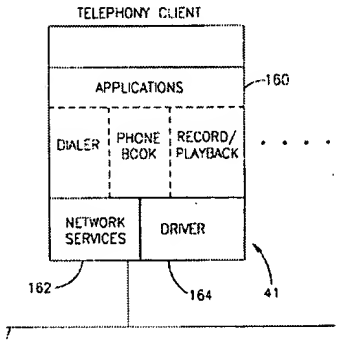


FIG.6

> Driver 164 allows telephony client host based software to communicate with the telephony client module installed within its host computer. At the next level is applications layer 160. Applications on telephony client 41 include a dialer, phone book and record/playback applications, for example... A record/playback application provides record and playback functions for use with voice mail and other applications. (*Baratz et al.*, Col. 10, Lines 37-46)

Thus, when the rejection argues that "each telephone and host computer *must* have a unique addresses" Applicant cannot agree. At best, the statement describes an arrangement that may occur in *Baratz et al.* -- that is, a possible arrangement. This is not sufficient to show anticipation:

> Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.[2]

Accordingly, because the rejection has not shown all the limitations of claim 1, either explicitly or inherently, this ground for rejection is traversed.

Applicant's amended claim 12 is believed to be separately patentable over the cited reference. Amended claim 12 recites that each VDM, telephone and computer have a unique address with respect to all other VDMs, telephones and computers connected to VDM modules. These new limitations present no new matter (see Applicant's Specification, Page 9, Lines 7-12).

Just as the cited reference *Baratz et al.* does not show separate addresses for a computer and telephone, the reference is not believed to show separate addresses for a telephone, computer and VDM.

[2] In re Oelrich, 121 USPQ 323, 326 (C.C.P.A. 1981) (quoting Hansgrig v. Kemmer, 40 USPQ 665, 667 (C.C.P.A. 1939).

Rejection of Claims 5-10 and 14-16 Under 35 U.S.C. §103(a), based on *Baratz et al.*

The rejection of claim 5 will first be addressed.

As is well known, to establish a prima facie case of obviousness, a rejection must meet three basic criteria. First, there must be some suggestion or motivation to modify a reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all claim limitations.[3]

Claim 5 depends from claim 1. Thus, to the extent that this ground for rejection relies on *Baratz et al.* to show the limitations of amended claim 1, the comments set forth for claim 1 are incorporated by reference herein. That is, because *Baratz et al.* does not show or suggest all the limitations of base claim 1, a prima facie case of obviousness has not been established.

In addition or alternatively, a prima facie case is not believed to have been established for claim 5, as the necessary motivation/suggest for the proposed combination is lacking.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The motivation set forth in the rejection of claim 5 is as follows:

> It would have been obvious... to have more than one telephony server module in Baratz because doing so has many benefits such as parallel processing wherein the processing power of more than one server can be used, thereby increasing the operating speed in the Baratz network and another benefit would be redundancy, wherein if one server fails there will be another server that can support the system, thereby making Baratz more reliable. (Final Office Action, Page 6, Lines 2-6).

Applicant has previously requested the source of this motivation. In addition, to clarify whether the Examiner was relying on official notice, Applicant seasonably traversed this statement and

[3] MPEP §2143.

requested the citation of a reference in support (see Applicant's previous Response to Office Action, dated 05/21/2004, Page 13, Lines 28-29).

No citation or reference has been provided. Instead, Applicant's comments were addressed by a restatement of the original rejection reasoning:

> Applicant argues that there is no motivation found in the reference for parallel processing and redundancy. The Examiner respectfully disagrees. As pointed out by Applicant on page 13 lines 15 and 16, a source of obviousness may be found *in knowledge generally available to one of ordinary skill in the art.* In this case parallel processing to increase processing power and redundancy to increase reliability *are* techniques and motivations that are generally available to one skilled in the art. (Final Office Action, dated 08/09/2004, Page 12, Lines 13-18).

Applicant regrets any confusion presented by citing the above authority. Applicant does not believe the above authority eliminates the requirement of some sort of evidence in support of a rejection, particularly when Applicant traverses the statement. Applicant does not doubt that the Examiner believes the above to be well known, however, simply stating so cannot meet the burden required for a prima facie case. It is well established that "skill in the art" cannot be used to fill gaps in a case of obviousness.[4]

Because the rejection reasoning has provided no basis for the conclusions relied upon to reject claim 5, Applicant does not believe a prima facie case of obviousness has been established, and this ground for rejection is traversed.

The rejection of claims 6-10 and 14-16 will now be addressed.

The invention of amended claim 6 is directed to a method for communicating between network elements in a voice and data network. The method includes (a) monitoring a communication network by a first voice and data module (VDM) for a call from a second VDM and a call from a link to a wide area network (LTW) connected to said communication network, (b) monitoring a first phone and a first computer attached to said first VDM for an outgoing call

[4] See All-Site Corp. v. VSI Intl'l, Inc., 50 USPQ2d 1161, 1171 (Fed. Cir. 1999).

to a destination containing a second phone and a second computer connected to said second VDM, or an outside phone and an outside computer network through said LTW.

The method also includes (c) detecting said outgoing call and connecting said call if said destination is not busy, else providing a busy signal and disconnecting said outgoing call, connecting said call including sending a request for connection packet with an address for said LTW as the destination address. Still further, as amended, claim 6 recites that a step (c) further includes sending a request for connection packet to a second VDM. That is, the first VDM sends a request for connection packet to a second VDM.

Such a limitation is not shown or suggested by *Baratz et al.*

As noted above, *Baratz et al.* teaches host computers with network interfaces and telephony client modules (NIC/TCM). The rejection argues that these structures correspond to Applicant's voice and data modules (VDMs):

> Note, the NIC and TCM cards of the host computer, as a whole, are being considered a voice and data module... (Final Office Action, dated 08/09/04, Page 3, Section 5, 3rd full paragraph).

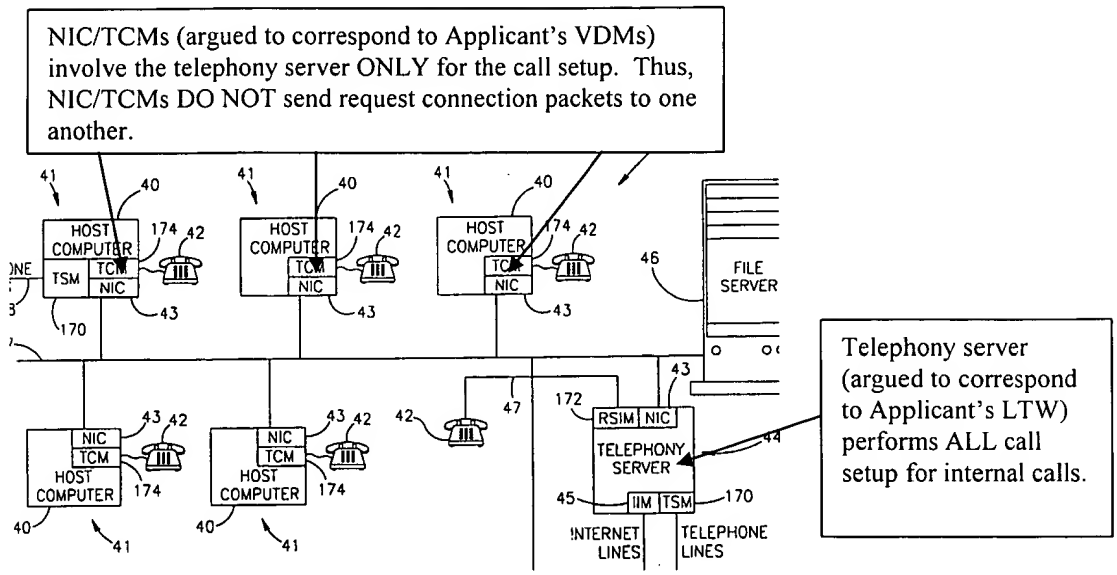
Additionally, the rejection argues that the telephony server of *Baratz et al.* corresponds to Applicant's link-to-wide area network (LTW):

> [A] link to wide area network (LTW) connects said telephone network to a Public Service Telephone Network (PSTN) and an Internet Service Provider (ISP) (a telephony server connects the network to the PSTN and Internet)... (Final Office Action, dated 08/09/04, Page 4, Lines 3-5).

Thus, rejection equates Applicant's VDM with the NIC/TCM of *Baratz et al.*, and Applicant's LTW with the telephony server of *Baratz et al.*

Under such reasoning, the limitations of amended claim 6 cannot be shown or suggested. *Baratz et al.* teaches host computers with NIC/TCM (i.e., VDMs) along with a telephony server (i.e., LTW), as shown below. *Baratz et al.* never describes a request for connection packet issued

from one NIC/TCM to another, and thus cannot be suggestive of Applicant's claim 6.



Baratz et al. clearly indicates that call initiation is never between one NIC/TCM and the other (i.e., between one VDM and another), but is restricted exclusively between a NIC/TCM and the telephony server:

> During operation of system 10, internal calls made from one extension to another extension ***involve the telephony server only for the call setup***, status monitoring and tear down of the call. (*Baratz et al.*, Col.5, Lines 63-66, emphasis added).

For this reason, the reference is believed to teach away from Applicant's invention, which presents device-to-device request for connection, as opposed to a centralized control of calling steps, as noted in *Baratz et al.*

Accordingly, *Baratz et al.* does not show or suggest all the limitations of Applicant's amended claim 6.

Claim 16 is believed to be separately patentable over the cited reference. Claim 16 recites that a step (d) further includes an LTW requesting an outside call to provide extension data for an incoming call, and if an extension number is not received, storing a predefined port address as a destination address in request for connection packet. Such a limitation is not shown or suggested by *Baratz et al.*

The rejection admits that the reference does not explicitly show the limitations of claim

16:

> Baratz does not disclose that if an extension is not received using a predetermined port address as the destination. (Final Office Action, dated 08/09/04, Page 9, Lines 17-18).

Thus, to show such a limitation, the rejection proposes modifying *Baratz et al.* as follows:

> [I]t would have been obvious... to implement this feature in Baratz because doing so will allow the call to still take place rather than dropping the call because the extension is unknown, thus making Baratz more reliable. Note, this becomes even more important for emergency calls made in the Baratz system. (Final Office Action, dated 08/09/04, Page 9, Lines 18-22).

As in the case of claim 5, Applicant has previously requested the source of this motivation. In addition, to clarify whether the Examiner was relying on official notice, Applicant seasonably traversed this statement and requested the citation of a reference in support (see Applicant's previous Response to Office Action, dated 05/21/2004, Page 16, Lines 18-21).

Therefore, for the same essential reasons as claim 5, this ground for rejection is traversed. Applicant believes that unsupported statements argued to be based on "skill in the art" cannot meet the burden required for a prima facie case of obviousness.

Rejection of Claim 13 Under 35 U.S.C. §103(a), based on *Baratz et al.* in view of *Angle et al.* (U.S. Patent 6,366,771)

To the extent that this rejection relies on *Baratz et al.*, the comments set forth above for claim 6 are incorporated by reference herein. In particular, various limitation of base claim 6 are not shown or suggested, thus a prima face case of obviousness does not exist.

Claims 1, 6 and 12-13 have been amended. Claim 15 has been cancelled. The present claims 1-14 and 16 are believed to be in allowable form. It is respectfully requested that the application be forwarded for allowance and issue.

Respectfully Submitted,

10/1/04

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